

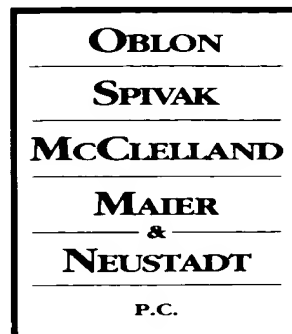


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DOCKET NO.: 0327-0759-0



ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Serial No.: 09/220,691
Applicant: Naoko TSUJI, et al.
Filing Date: DECEMBER 28, 1998
For: METHOD OF INHIBITING HAIR
GROWTH
Group Art Unit: 1651
Examiner: WEBER

ATTORNEYS AT LAW

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SIR:

~~RESPONSE UNDER 37 C.F.R. 1.116-~~
~~EXPEDITED PROCEDURE EXAMINING~~
~~GROUP 2.2.2.~~

Attached hereto for filing are the following papers:

Response and Request for Reconsideration Under 37 C.F.R. 1.116 (Final Rejection);
Request for One-Month Extension of Time;
Request for Priority;
Certified English Translation of Japanese Patent Application No. 10-005959

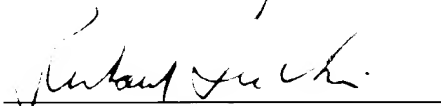
Our check in the amount of **\$110.00** attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. §1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. §1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Naoko TSUJI, et al.

SERIAL NO.: 09/220,691

FILED: DECEMBER 28, 1998

FOR: METHOD OF INHIBITING HAIR :
GROWTH

:

: EXAMINER: WEBER

: GROUP ART UNIT: 1651

:

RESPONSE UNDER 37 CFR 1.116--
EXPEDITED PROCEDURE EXAMINING
GROUP 1.1.1

RESPONSE AND REQUEST FOR RECONSIDERATION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Responsive to the outstanding Official Action of February 16, 2001, reconsideration of the above-identified application is respectfully requested in view of the following remarks:

REQUEST FOR RECONSIDERATION

Claims 1, 3-4 and 6-12 remain active in this application.

The present invention is directed to a method of inhibiting hair growth.

Applicants wish to thank Examiner Weber for the helpful and courteous discussion held with their U.S. representative on April 1, 2001. At that time, Applicants' U.S. representative argued that the claims were enabled for the present scope of administration to an affected area of a subject in need thereof, an inhibitor of elastase-like enzymes or a neutral endopeptidase inhibitor, and that the negative limitation of the elastase-like enzyme not being a matrix metalloproteinase inhibitor simply excluded from the claimed subject matter those

inhibitors of elastase-like enzyme which are matrix metalloproteinase inhibitors. The following is intended to expand upon the discussion with the Examiner.

The rejection of Claims 1, 3-4 and 6-10 under 35 U.S.C. §102(a) over Tsuji et al JP 10-265359 is respectfully traversed.

Applicants note, that Tsuji et al has a publication date of October 6, 1998. Applicants have requested the benefit to priority to Japanese application 10-005959 filed with the Japanese Patent Office on October 14, 1998. In order to perfect Applicants' claim to priority, Applicants enclose herewith a certified English translation of JP 10-005959. A certified copy of Applicants' priority document was submitted on December 28, 1998. Applicants respectfully request the full benefit of priority to Japanese application 10-005959. Since Applicants' priority date of January 14, 1998 is before the publication date of Tsuji et al, the reference Tsuji et al is not available as prior art and accordingly withdrawal of the rejection under 35 U.S.C. §102(a) is respectfully requested.

The rejection of Claims 1, 3-4 and 6-21 under 35 U.S.C. §112, first paragraph, is respectfully traversed.

Applicants respectfully submit that the claimed invention is described in such sufficient detail as to enable one of ordinary skill in the art to practice the claimed invention without undue experimentation.

Claim 1 recites a method of inhibiting hair growth, comprising topically administering to an affected area of a subject in need thereof an inhibitor of elastase-like enzymes or a neutral endopeptidase inhibitor, wherein said inhibitor of elastase-like enzymes are not a matrix metalloproteinase inhibitor. The present invention may be practiced by those of ordinary skill in the art without undue experimentation by simply administering to the

affected area of a subject in need thereof an inhibitor of elastase-like enzymes or a neutral endopeptidase inhibitor. This is all that is needed to enable those of ordinary skill in the art to practice the subject matter of the claimed invention. However, the present claims do not cover the act of inhibiting hair growth by administering to an affected area of a subject in need thereof an inhibitor of an elastase-like enzyme which is a matrix metalloproteinase inhibitor. Accordingly, Applicants' claimed subject matter does not require those of ordinary skill in the art to determine inhibitors of elastase-like enzymes which are not matrix metalloproteinase inhibitors, but rather only requires the determination of an inhibitor of elastase-like enzymes, the subject matter where the inhibitor of elastase-like enzyme being a matrix metalloproteinase inhibitor, not being within the scope of the claimed subject matter. Applicants' respectfully submit that the claimed subject matter is sufficiently described in such a way as to enable those of ordinary skill in the art to practice the claimed invention without undue experimentation. In view of the above arguments, withdrawal of the rejection under 35 U.S.C. §112, first paragraph, is respectfully requested.

Applicants submit this application is now in condition for allowance and early notification of such action is earnestly solicited.

Respectfully submitted,

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